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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,207

06/16/2006

Maria Sundqvist

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EXAMINER

TURNER, ARCHENE A

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

04/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/583,207	Applicant(s) SUNDQVIST ET AL.	
	Examiner ARCHENE TURNER	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/06</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 5,11,13,14,15,18 recites the broad recitation 0.8-1.2 % of C, and the claim also recites about 1% of C which is the narrower statement of the range/limitation.

3. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat.

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App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 10,20 recites the broad recitation carbides and nitrides, and the claim also recites TiC, NbC and/or TiN which is the narrower statement of the range/limitation.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Droese et al (6,612,204) or Duroc AB (WO 99/56906) or Inventing SA (GB 2130924) or

Droese et al or Duroc AB or Inventing SA disclose the claimed nitride, carbide or oxide coating on a doctor blade on a steel substrate. Since the disclosed composition of the steel is a conventional one, then it is the examiner's position

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that it is included in the generic disclosure of steel in the reference. The claimed hardness is considered inherent to the composition of the claimed coating.

6. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Cerasiv Innovatives Keramikeng (DE 4139105) or Norton (GB 1 289 609) or Lodding (GB 978,988).

Cerasiv Innovatives Keramikeng or Norton or Lodding disclose the claimed coating on a doctor blade with the claimed hardness.

7. Claims 1-4,6-8,10,12,19,20 are rejected under 35 U.S.C. 102(b) as being anticipated by Inst. Nat. Polytechnique Grenoble (FR 2369885).

Inst. Nat. Polytechnique Grenoble discloses the claimed Ti compound coating on a blade. The claimed hardness is considered inherent to the composition of the claimed coating.

8. Claims 1-4,6, 7,10,12,19,20 are rejected under 35 U.S.C. 102(b) as being anticipated by Maybon (5,896,902).

Maybon discloses the claimed carbide coating on a blade and the claimed method of making. The claimed hardness is considered inherent to the composition of the claimed coating.

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9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cerasiv Innovatives Keramikeng (DE 4139105) or Norton (GB 1 289 609) or Lodding (GB 978,988) in view of Boucher et al (4,484,959).

Cerasiv Innovatives Keramikeng or Norton or Lodding disclose the claimed coating on a substrate.

Bloucher et al discloses the claimed steel composition.

Thus it would have been obvious to one of ordinary skill in the art to provide Cerasiv Innovatives Keramikeng or Inst. Nat. Polytechnique Grenoble or Maybon with the claimed steel composition, as these compositions are well known in the steel art, as shown by Bloucher et al.

11. Claims 5,11,13-15,18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inst. Nat. Polytechnique Grenoble (FR 2369885) or Maybon (5,896,902) in view of Boucher et al (4,484,959).

Inst. Nat. Polytechnique Grenoble or Maybon or disclose the claimed coating on a substrate.

Bloucher et al discloses the claimed steel composition.

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Thus it would have been obvious to one of ordinary skill in the art to provide Cerasiv Innovatives Keramikeng or Inst. Nat. Polytechnique Grenoble or Maybon with the claimed steel composition, as these compositions are well known in the steel art, as shown by Bloucher et al.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Archene Turner whose new telephone number is (571) 272-1545. The examiner can normally be reached on Monday, Wednesday through Friday from 10:30 am. to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Please remember to include on the fax, the art unit 1775, serial number and Examiner's name.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**/A. A. Turner/
Primary Examiner
Group 1700**

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